

REMARKS

Claims 1, 5, 12, 21 and 22 have been amended. Claims 2-4, 6-11, and 13-20 remain in the application unchanged. Reexamination and reconsideration of the application are respectfully requested.

In the Office Action dated 9/8/04, claims 1-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weinberger, U.S. Patent No. 6,499,027 (hereinafter "Weinberger '027") in view of Clemens, PCT Patent Publication No. WO 99/40723 (hereinafter "Clemens '723"). Applicants believe that these claims are allowable over the cited references for the reasons discussed below.

Claims 12-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weinberger '027") in view of Lafreniere, U.S. Patent No. 4,821,118 (hereinafter "Lafreniere '118"). Applicants believe that these claims are allowable over the cited references for the reasons discussed below.

Claims 21-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weinberger '027 in view of Clemens '723 and further in view of Lafreniere '118. Applicants believe that these claims are allowable over the cited references for the reasons discussed below.

Legal Standard for Claim Rejection Under 35 U.S.C. §103

The test for obviousness under 35 U.S.C. §103 is whether the claimed invention would have been obvious to those skilled in the art in light of the knowledge made available by the references. *In re Donovan*, 184 USPQ 414, 420, n. 3 (CCPA 1975). It requires consideration of the entirety of the disclosures of the references. *In re Rinehart*, 189 USPQ 143, 146 (CCPA 1976). All limitations of the claims must be considered. *In re Boe*, 184 USPQ 38, 40 (CCPA 1974). In making a

determination as to obviousness, the references must be read without benefit of Applicants' teachings. *In re Meng*, 181 USPQ 94, 97 (CCPA 1974). In addition, the propriety of a §103 rejection is to be determined by whether the reference teachings appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination, or other modifications. *In re Lintner*, 173 USPQ 560, 562 (CCPA 1972). A reference which teaches away from the Applicants' invention may not properly be used in framing a 35 U.S.C. §103 rejection of Applicants' claims. See *United States v. Adams*, 148 USPQ 479, 484 (1966).

A basic mandate inherent in §103 is that a piecemeal reconstruction of prior art patents shall not be the basis for a holding of obviousness. It is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *In re Kamm*, 172 USPQ 298, 301-302 (CCPA 1972).

When determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Ecolochem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1073 (Fed. Cir. 2000). In other words, there must be something in the teachings of cited references to suggest to an individual skilled in the art that a claimed invention would be obvious. *W. L. Gore and Associates v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983). This position was reaffirmed in the case of *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 43 USPQ 2d 1294 (Fed. Cir. 1997). *Arkie Lures* involved the combination of a plastic fishing lure with salt materials to yield a highly attractive lure

product. The prior art disclosed both concepts (salty bait and plastic lures) separately but not in combination. The CAFC ultimately held that the invention under consideration was not obvious. Even though both of the claimed features were disclosed by the cited art, the CAFC concluded that this was insufficient to prove a case of obviousness in the absence of a teaching or suggestion in the art to combine the references.

Likewise, the requirement that a **concrete suggestion** be present in the cited art for a proper obviousness rejection to be made is even further supported by *C.R. Bard Inc. v. M3 Systems Inc.*, 48 USPQ 2d 1225 (Fed. Cir. 1998). This case involved an allegation that a particular medical needle apparatus was merely a product of "obvious modifications" to a prior needle assembly. The CAFC disagreed and stated that the claimed invention was neither suggested nor taught by the prior art, and further indicated that the "invention that was made, however, does not make itself obvious; **that suggestion or teaching must come from the prior art**" itself. 48 USPQ 2d at 1232 (emphasis added). The CAFC also concluded that the requisite suggestion or teaching was so important that, in its absence, the claimed invention could not have been obvious. According to the court, "Absent this essential evidentiary component of an obviousness holding, as a matter of law the verdicts of invalidity on that ground cannot stand. Consequently, the judgment of invalidity based on obviousness is reversed." 48 USPQ 2d at 1232.

Rejection of Claims 1-11

As noted above, claims 1-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weinberger '027 in view of Clemens '723. Applicants believe that these claims are allowable over the cited references for the following reasons.

Weinberger '027 is directed to a passenger entertainment system (100) that provides services to passengers in the form of audio and video on-demand, information dissemination, product and service order processing, video teleconferencing using a video camera (267) at each passenger's seat, and data communication services between on-board passengers and others via a communications link. A passenger may select from a menu of services using a passenger control unit (121) with depressible buttons.

As noted by the Examiner on page 2 of the Office Action, Weinberger '027 does not provide a digital camera. In addition, Weinberger '027 does not disclose or suggest Applicants' claim 1, with particular emphasis on the underlined elements below:

1. (As amended above) A communications system, comprising:
 - a) a plurality of communications units fixedly mounted onboard an airplane, each of said communications units being adapted to be operated by an associated passenger to perform digital image viewing functions, whereby each of said communications units comprises at least one receiver adapted to receive image data that is stored on a digital camera memory device and input by said associated passenger and display said image data on a video screen; and
 - b) at least one processor operatively connected to said at least one receiver and said video screen.

Claim 1 was amended above in order to more clearly identify the image data ("image data that is stored on a digital camera memory device"), which was implied

In Applicants' claim 1 prior to amendment thereof and is discussed in Applicants' Specification.

As noted above, the passenger control unit (121) of Weinberger '027 includes depressible buttons that may be used to choose items from a menu. Thus, it is clear that the passenger control unit (121) of Weinberger '027 could not possibly function as a "receiver adapted to receive image data that is stored on a digital camera memory device and input by said associated passenger and display said image data on a video screen" as claimed in Applicants' claim 1.

Clemens '723 is directed to a system for capturing a still image during video streaming operations using a digital camera (10) that is connected to a computer (12). In other words, a digital camera (10) with dual still image and video streaming capabilities is disclosed.

On page 3 of the Office Action, in combining Weinberger '027 and Clemens '723 to reject Applicants' claims, the Examiner states that "...it would have been obvious... to combine Weinberger'[s] passenger entertainment system with the image capture apparatus, as disclosed by [Clemens]. Doing so would provide still and video images through the same signal processing system, thereby reducing the cost to the consumer of purchasing separate still and video cameras...." Applicants respectfully traverse. As noted above, Weinberger '027 includes a video camera (267) at each passenger's seat so that the passenger may be viewed during a teleconference. Thus, the video capture as taught by Weinberger '027 is limited to the passenger and his/her immediate area onboard an airplane. Also as noted above, Clemens '723 discloses a system for capturing a still image during video streaming operations using a digital camera (10) that is connected to a computer (12). A combination of Weinberger '027 and Clemens '723 could allow the video

camera of Weinberger '027 to capture still images of a passenger and his/her immediate area during a teleconference. However, this is not Applicants' claimed invention, which allows a passenger to input image data stored on a digital camera memory device (e.g., still images from a vacation or the like) and view that image data on a video screen at his/her seat.

Furthermore, assuming for the sake of argument that the combination of Weinberger '027 and Clemens '723 did somehow produce Applicants' invention as claimed in claim 1, the combination of these references is entirely improper in that there is absolutely no suggestion in either reference that would motivate one skilled in the art to combine these references. More specifically, there is nothing in Weinberger '027 to suggest that its communications system with video teleconferencing capabilities should or could be modified to include a digital camera with dual still image and video streaming capabilities such as that taught by Clemens '723. There is also nothing in Clemens '723 that would suggest that its system including a digital camera and a computer should be utilized onboard an airplane. As discussed above, a concrete suggestion must be present in the cited art for a proper obviousness rejection to be made, and that suggestion or teaching must come from the prior art itself. *C.R. Bard Inc. v. M3 Systems Inc.*, 48 USPQ 2d 1225 (Fed. Cir. 1998). Since neither Weinberger '027 nor Clemens '723 provides the necessary suggestion to combine these references in an attempt to produce Applicants' claimed invention, such a combination should not be made.

For at least these reasons, Applicants' claim 1 is believed to be allowable over the cited references. Claims 2-11, which are each directly or ultimately dependent on claim 1, are believed to be allowable as depending from an allowable

base claim, and also because of the novel and nonobvious combination of elements disclosed therein.

Rejection of Claims 12-20

Claims 12-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weinberger '027") in view of Lafreniere, U.S. Patent No. 4,821,118 (hereinafter "Lafreniere '118"). Applicants believe that these claims are allowable over the cited references for the following reasons.

None of the cited art, either alone or in combination, discloses or suggest Applicants' claim 12, with particular emphasis on the underlined elements below:

12. (As amended above) A communications system, comprising:

- a) a plurality of communications units fixedly mounted onboard an airplane, each of said communications units being adapted to be operated by an associated passenger to perform scanning functions, whereby each of said communications units comprises a scanner adapted to scan a document provided by said associated passenger and display a scanned image of said document on a video screen;
- b) at least one processor operatively connected to said scanner and said video screen; and
- c) at least one remote connection device adapted to connect each of said communications units to a remote location in order to send said scanned image of said document to said remote location.

Claim 12 was amended in order to expressly state the relationship between the remote connection device and the scanner, which was implicit in the claim prior

to this amendment. As noted by the Examiner on page 4 of the Office Action, Weinberger '027 does not disclose "a scanner adapted to scan a document and display a scanned image of said document on a video screen." The Examiner also states that "...Lafreniere (fig. 14) discloses a video system for personal identification. The system comprises a scanner (124) adapted to scan a document and display a scanned image of said document on a video screen (142)."

Lafreniere '118 is directed to a video image system for rapidly recording a person and his identification card, combining those images, and presenting the combined image on a video monitor for immediate inspection by a guard, store clerk or attendant. The system includes a video scanner (124) for scanning the identification card and a video cameras (111, 123) for providing images of the person's palm and face.

The combination of Weinberger '027 with Lafreniere '118 is entirely improper since there is absolutely no suggestion in either reference that would motivate one skilled in the art to combine these references. As discussed above, a concrete suggestion must be present in the cited art for a proper obviousness rejection to be made, and that suggestion or teaching must come from the prior art itself. *C.R. Bard Inc. v. M3 Systems Inc.*, 48 USPQ 2d 1225 (Fed. Cir. 1998). More specifically, there would be no motivation to provide a communications system for use by an airplane passenger as taught by Weinberger '027 that includes a scanner that scans a passenger's identification card (and a video camera that captures images of the passenger's face and palm) as taught by Lafreniere '118 since **identification of airplane passengers occurs before the passenger reaches his/her seat**. For the same reason, there would be no motivation to provide a video image system of Lafreniere '118 for each passenger on an airplane. If anything, the Lafreniere '118

system should be set up in an airport terminal for passengers to identify themselves before boarding an airplane. However, this is not Applicants' invention as claimed in claim 12. Since neither Weinberger '027 nor Lafreniere '118 provides the necessary suggestion to combine these references in an attempt to produce Applicants' claimed invention, such a combination cannot properly be made.

For at least these reasons, Applicants' claim 12 is believed to be allowable over the cited references. Claims 13-19, which are each directly dependent on claim 12, are believed to be allowable as depending from an allowable base claim, and also because of the novel and nonobvious combination of elements disclosed therein.

Rejection of Claims 21-22

Claims 21-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weinberger '027 in view of Clemens '723 and further in view of Lafreniere '118. Applicants believe that these claims are allowable over the cited references for the same reasons discussed above regarding claims 1 and 12.

Conclusion


For at least the reasons discussed above, Applicants believe that all of the pending claims (claims 1-22) are allowable over the cited references. Therefore, Applicants respectfully request that the Examiner reconsider the application and grant an early allowance.

Should there be any questions regarding this Amendment, the Examiner may contact Applicants' attorney at the telephone number listed below.

Respectfully submitted,

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